

DETAILED ACTION

1. Claims 1-16 are pending in the application.

REJECTIONS

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102/103

3. Claims 1-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mori et al. (U.S. Patent No. 6,326,086).
4. Regarding claims 1-3, 7, 13-15, Mori et al. teaches a laminate decorative sheet for simultaneous decoration and injection molding (col. 1, lines 8-16, 59-67, col. 2, lines 1-5) which comprises a base film and a decorative layer provided on the base film (col. 1, lines 59-67, col. 2, lines 1-4). The decorative sheet has an elongation at break as measured at 110 °C of not less than 150% which reads on Applicant's claimed range of 200 to 400% (col. 8, lines 25-44). While the ambient temperature is set to 110 °C, Mori et al. teaches wherein the suitable temperature range for measurement is 110 to 130 °C since this is the temperature suitable for three-dimensionally performing a film (col. 8, lines 13-18). Mori et al. is silent on the elongation at break as measured at 25 °C of 3 to 10%, in both a flow direction during formation of the base film and a direction

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perpendicular to the flow direction and 40 °C of 10 to 20%. It is elementary that a mere recitation of a newly discovered property, inherently possessed by the things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art (In re Swinehart et al, 169 USPQ 226 at 229). It is therefore inherent that the inclusion of the same resin composition in Mori et al. would possess the same elongation at break as measured in both a flow direction during formation of the base film and a direction perpendicular to the flow direction at 25 °C and 40 °C as the instant application because it possesses all the other claimed properties in the same structure.

5. In the alternative, one of ordinary skill in the art would deem the elongation at break as measured at 25 °C of 3 to 10%, in both a flow direction during formation of the base film and a direction perpendicular to the flow direction, and 40 °C of 10 to 20% of an acrylic resin an obvious property of the resulting material. Mori et al. teaches a laminate decorative sheet for simultaneous decoration and injection molding (col. 1, lines 8-16) which comprises a base film comprising polymethacrylate with acrylic rubber or butadiene rubber within and a decorative layer provided on the base film (col. 1, lines 59-67, col. 2, lines 1-4, col. 8, lines 45-51). The resulting decorative sheet has an elongation at break as measured 110 °C of not less than 150% which reads on Applicant's claimed range of 200 to 400% (col. 8, lines 25-44). Additionally, Mori et al. teaches 110 °C is the lower value of the temperature range of 110 °C to 130 °C which is suitable for three-dimensionally preforming a film having a low softening point such as acryls (col. 7, lines 8-17, col. 8, lines 13-17). It is therefore obvious that the elongation at break as measured in both a flow direction during formation of the base film and a

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direction perpendicular to the flow direction at 25 °C of 3 to 10% and 40 °C of 10 to 20% is an understood property to one of ordinary skill in the art because it possesses all the other claimed properties in the same structure.

6. Regarding claims 4-5 and 8-9, Mori et al. teaches a decorative sheet for simultaneous decoration and injection molding (col. 1, lines 8-16) wherein the base film is formed of an acrylic resin composition containing polymethacrylate or a derivative thereof as a primary component (col. 8, lines 46-51).

7. Regarding claims 6 and 10, Mori et al. teaches a decorated resin molded product comprising a resin molding and a decorated sheet wherein the decorative layer of the decorative sheet is bonded to the molding (col. 1, lines 59-67, col. 2, lines 1-5).

8. Regarding claim 11, Mori et al. teaches decorative sheet for simultaneous decoration and injection molding (col. 1, lines 8-16) wherein the base film includes at least on rubber material selected from the group consisting of acrylic rubber (col. 8, lines 45-51) and butadiene rubber (col. 10, lines 33-38).

9. Regarding claim 12, Mori et al. teaches a decorative sheet for simultaneous decoration and injection molding (col. 1, lines 8-16) wherein the butadiene (rubber material) content included the base film is within a range of 20 to 50% by weight material which reads on Applicant's claimed range of 3 to 30 parts by mass based on 100 parts by mass (col. 10, lines 33-46). One of ordinary skill in the art would be able to convert the given weight percent to parts by mass when given the appropriate mass of the components within the material.

10. Regarding claim 16, Mori et al. teaches a decorative sheet for simultaneous decoration and injection molding (col. 1, lines 8-16) wherein the decorative sheet further comprises an adhesive layer such that the adhesive layer and base film sandwich the decorative layer (col. 13, lines 61-65, col. 14, lines 27-32, Fig. 6).

Response to Arguments

11. Applicant's arguments in the response filed 10/6/2011 regarding claims 1-10 of record have been carefully considered but are deemed unpersuasive. With respect to the claim rejections, Applicant has amended their claims in order to claim further aspects of the present invention. Specifically, Applicant has added new claims 11-16 to the application. Applicant argues that Mori et al. (US Patent No. 6,326,086) would have neither disclosed nor would have suggested a decorative sheet for simultaneous decoration and injection molding as in the present claims, having the recited elongation at break as measured at 120 °C and wherein this decorative sheet also has an elongation at break as measure at 25 °C of 3-10%. However, it is respectfully submitted that Mori et al. does disclose and suggest a decorative sheet as in the present claims.

12. Mori et al. teaches a laminate decorative sheet for simultaneous decoration and injection molding (col. 1, lines 8-16, 59-67, col. 2, lines 1-5) which comprises a base film comprising polymethacrylate with acrylic rubber or butadiene rubber such as acrylonitrile butadiene styrene within and a decorative layer provided on the base film (col. 2, lines 1-4, col. 8, lines 45-51, col. 10, lines 32-37). Mori et al. teaches that the rubber based resin is included for its stretchable behavior and therefore allowing a film

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comprising said rubber based resin to exhibit a higher elongation behavior (col. 9, lines 17-38, col. 10, lines 32-37). It is evident that the film of Mori et al. is prepared with the desire to produce highly stretchable material. The decorative sheet has an elongation at break as measured at 110 °C of not less than 150% which reads on Applicant's claimed range of 200 to 400% (col. 8, lines 25-44). While the ambient temperature is set to 110 °C, Mori et al. teaches wherein the suitable temperature range for measurement is 110 to 130 °C since this is the temperature suitable for three-dimensionally performing a film (col. 8, lines 13-18). Mori et al. is silent on the elongation at break as measured in both a flow direction during formation of the base film and a direction perpendicular to the flow direction at 25 °C of 3 to 10% and 40 °C of 10 to 20%. It is elementary that a mere recitation of a newly discovered property, inherently possessed by the things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art (In re Swinehart et al, 169 USPQ 226 at 229). It is therefore concluded that the inclusion of the same resin composition in Mori et al. would possess the same elongation at break as measured at 25 °C, 40 °C and 120 °C as measured in both a flow direction during formation of the base film and a direction perpendicular to the flow direction as the instant application because it possesses all the other claimed properties in the same structure.

13. In the alternative, one of ordinary skill in the art would deem the elongation at break as measured in both a flow direction during formation of the base film and a direction perpendicular to the flow direction at 25 °C of 3 to 10% and 40 °C of 10 to 20% of an acrylic resin an obvious property of the resulting material. Mori et al. teaches a

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laminate decorative sheet for simultaneous decoration and injection molding (col. 1, lines 8-16) which comprises a base film comprising polymethacrylate with acrylic rubber or butadiene rubber within and a decorative layer provided on the base film (col. 2, lines 1-4, col. 8, lines 45-51). The resulting decorative sheet has an elongation at break as measured 110 °C of not less than 150% which reads on Applicant's claimed range of 200 to 400% (col. 8, lines 25-44). Additionally, Mori et al. teaches 110 °C is the lower value of the temperature range of 110 °C to 130 °C which is suitable for three-dimensionally preforming a film having a low softening point such as acryls (col. 7, lines 8-17, col. 8, lines 13-17). It is therefore obvious that the elongation at break as measured in both a flow direction during formation of the base film and a direction perpendicular to the flow direction at 25 °C of 3 to 10% and 40 °C of 10 to 20% is an understood property to one of ordinary skill in the art because it possesses all the other claimed properties in the same structure.

14. Applicant submits that Comparative Example 3 on pages 34 and 35 rebuts the conclusion of inherency. However, it is noted that Comparative Example 3 is related to a polycarbonate film which is not relied on in Mori et al. Mori et al. teaches wherein the polyacrylate resin comprises comparable amounts of acrylic rubber or butadiene rubber such as acrylonitrile butadiene styrene with and a decorative layer provided on the base film (col. 2, lines 1-4, col. 8, lines 45-51, col. 10, lines 32-37). Applicant' allegation fails to show how Mori et al. is lacking in inherent properties.

15. Additionally, the allegation that Mori et al. does not describe the elongation at break at 25 °C does not overcome the conclusion of obviousness. The obviousness

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rejection is proper in that the decorative sheet employed by Mori et al. comprises substantially similar material obtained by the similar methods, employed for the same reasons as disclosed by Applicant including an interior material for vehicles and miscellaneous goods. One of ordinary skill in the art would deem the elongation at break as measured at 25 °C of 3 to 10% and 40 °C of 10 to 20%, in both a flow direction during formation of the base film and a direction perpendicular to the flow direction, of an acrylic resin an obvious property of the resulting material. Furthermore, the argument of unexpectedly better results achieved in the instant application is additionally deemed to be an obvious property of decorative sheet of Mori et al. The mere fact that Mori et al. does not refer to trimming is not persuasive in regards to the obviousness rejection. The decorative sheet of Mori et al. is substantially similar to that of Applicant and therefore one of ordinary skill in the art would expect the material to display similar results.

16. Therefore, Mori et al. teaches all of the limitations of instant claims 1-16.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHINESSA ADKINS whose telephone number is (571)270-5543. The examiner can normally be reached on Monday - Friday; 8:00 - 4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alicia Chevalier can be reached on 571-272-1490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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